



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 8960

Outi HIIRONNIEMI

Art Unit: 2154

Application No.: 10/086,780

Examiner: T. D. Nguyen

Filed: February 28, 2002

Attorney Dkt. No.: 059643.00741

For: METHOD AND SYSTEM FOR DYNAMIC REMAPPING OF PACKETS FOR A ROUTER

**RENEWED PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. §1.137(b)**

MAIL STOP: PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 30, 2008

Sir:

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the U.S. Patent & Trademark Office. This application was unintentionally abandoned.

Applicants respectfully petitioned for revival of this application on August 17, 2007 ("the original petition"). The original petition and its accompanying amendment are already of record. A renewed petition was submitted on March 4, 2008.

In accordance with the requirements for reviving an unintentionally abandoned application under 37 C.F.R. §1.137(b), Applicants hereby state the following.

- (1) Petition fee of \$1,500 was enclosed with the original petition;
- (2) A reply to the pending final Office Action in the form of an Amendment was enclosed with the original petition; and

(3) The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

A check in the amount of One Thousand Five Hundred Dollars (\$1,500) to cover the above fee was enclosed with the original petition.

In the event that the previously enclosed check was (or is) found to be insufficient, or if any additional fees are due with respect to the filing of this paper, please charge Counsel's Deposit Account Number 50-2222.

On March 4, 2008, the Office of Petitions issued an action denying the renewed petition. This denial was in error, and both the renewed and/or the original petition should be granted.

The denial stated that the petition lacked item (2), the required reply. However, the denial acknowledged that an amendment was submitted. The denial incorrectly stated that the amendment submitted with the petition "does not *prima facie* place the application in condition for allowance." The denial did not provide any explanation as to how the amendment failed to place the application in condition for allowance.

The denial, however, did set forth the legal standard according to which the amendment is to be judged, providing four alternative ways by which the amendment may be deemed proper. That the four ways are alternatives can be seen from the fact that items (1) (a Notice of Appeal) and (4) (a Request for Continuing Examination) are mutually exclusive.

In this case, the amendment submitted with the original petition qualifies under the second option: "(2) an amendment that *prima facie* places the application in condition for allowance."

The amendment submitted with the original petition *prima facie* places the application in condition for allowance, because it cancels all of the rejected claims, leaving only allowed claims in the application. As noted in the amendment, claims 1-30 were previously pending, of which claims 1-22 had been allowed, and claims 23-30 had been rejected. Claims 23-30 were rejected without prejudice or disclaimer. Claims 23-

30 were cancelled in the amendment. No other amendments were made. Thus, the amendment *prima facie* places the application in condition for allowance, since it results in only allowed claims remaining pending in the application.

If the amendment submitted with the original petition does not qualify under alternative (2) (not admitted), it cannot be imagined what amendment could possibly qualify under alternative (2). Since the Office of Petitions has, in its decision, acknowledged the validity of alternative (2), and since the Office of Petition has not stated any reason (whatsoever) as to why the amendment does not qualify under alternative (2), it stands to reason that the amendment was proper, and the denial of the petition was improper.

Because there was no explanation in the original dismissal of the original petition or in the dismissal of the renewed petition as to why the response did not place the application *prima facie* in condition for allowance, Applicant's representative contacted Mr. Cliff Congo, the "Petitions Attorney" that signed the dismissal.

As related by telephone, Mr. Congo's basis for the rejection failing to place the application *prima facie* in condition for allowance was that he had emailed the assistant examiner for the application, and inquired whether the response *prima facie* placed the application in condition for allowance. The assistant examiner had evidently responded that it did not, providing as explanation that there was an unaddressed rejection under 35 U.S.C. 112.

The assistant examiner's assertion is factually incorrect. As can be seen from the Office Action of May 30, 2007, no rejection under 35 U.S.C. 112, was presented. Furthermore, the only rejected claims were claims 23-30, which were cancelled in the amendment submitted. Therefore, it is respectfully submitted that the amendment does *prima facie* place the application in condition for allowance.

If the assistant examiner believes that a new rejection is to be made under 35 U.S.C. 112, the appropriate mechanism is for him to prepare a new Non-Final Office Action, in which that rejection is presented for Applicant's consideration and, if

appropriate, amendment of the claims.

It is inappropriate, however, for the assistant examiner to insist that an amendment that cancels all rejected claims fails to comply with 37 C.F.R. §1.137(b)(2). Indeed, upon entry of the amendment, there is no rejection of record relevant to the claims.

As explained in MPEP 711.03(b), the appropriate handling of the petition is as follows (emphasis added):

An application subject to a final action in which a proposed amendment under 37 CFR 1.116 is filed as the required reply will normally be routed by the Office of Petitions to the Technology Center (TC) to determine whether a proposed amendment places the application in condition for allowance prior to granting any petition to revive such application. The examiner is instructed that if the reply places the application in condition for allowance, the examiner should write in the margin of the reply "OK to enter upon revival." For Image File Wrapper (IFW) processing, see IFW Manual. If the petition is otherwise grantable and the examiner indicates that the reply places the application in condition for allowance, the petition will be granted. If, on the other hand, the reply would not place the application in condition for allowance, the examiner is instructed to complete form PTOL-303 and return the form to the Office of Petitions with the application. Form PTOL-303 should not be mailed to the applicant by the examiner. In this situation, the Office of Petitions will not grant the petition. **A copy of the form PTOL-303 is marked with the notation "Courtesy Copy" by the Office of Petitions. The courtesy copy is sent as an attachment with the decision on the petition.** The advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the amendment after final rejection.

Applicants respectfully note that no PTOL-303 was included as an attachment to the decision on the petition or as an attachment to the decision on the renewed petition. Thus, it appears that USPTO policy has not been followed in the dismissal of the petition. It is respectfully submitted that the Examiner has already indicated claims 1-22 allowed (see, for example, the summary sheet of the Office Action mailed May 30, 2007), and that only claims 1-22 are currently pending in the application after the amendment. Applicants respectfully submit that no reasonable examiner could insist that

such an amendment does not place the application in condition for allowance.

While a new ground of rejection may exist (not admitted), such a rejection is not *prima facie* at least because it is not of record. Thus, the appropriate mechanism if such a rejection existed would be for the petitions branch to grant the petition and return the application to the Technology Center for processing by the Examiner who wishes to issue some new rejection of the claims.

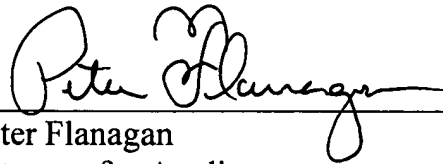
Applicant is not insisting that no new rejections can be made, just that it is not reasonable for Applicant's amendments to address rejections that are not of record. Applicant reminds the USPTO that in view of 35 U.S.C. 101, claims in a patent application are presumably allowable until a reason for rejection is presented. Since no rejection of claims 1-22 is of record, consequently they are allowable *prima facie*. Thus, the response clearly is a response that complies with 37 CFR 1.137(b)(2).

Furthermore, it is respectfully submitted that the question of whether this response complies with 37 CFR 1.137(b)(2) is a purely legal question, and consequently does not require recourse to the TC in order to decide the petition. As set forth above, the legal question is: **does the amendment overcome every rejection presented in the Office Action?** The answer is clearly yes, because **the amendment cancels all rejected claims**. Furthermore, there is no other legal issue that the amendment creates, because all that the amendment does is cancel the rejected claims. There are no other amendments, and none of the amendments raise new issues, such as cancellation of independent claims from which still-pending dependent claims depend.

In short, there are no matters for which the particular technological training of the Examiner is required in order to decide this petition. Thus, this is not one of the usual situations in which it would be necessary for the Petitions Branch to refer this to the Technology Center, because no technological issues are presented. Applicant's amendment *prima facie* places the application in condition for allowance because it cancels all the rejected claims and does not modify in any way the already-allowed claims. Thus, the petition ought to be granted.

Accordingly, grant of the original petition or the renewed petition (or, in the further alternative, of this further renewed petition) is respectfully requested, and timely issuance of a formal notice of allowance is respectfully requested, as all of the claims pending after the amendment have been allowed. As noted above, the fees for the petition have already been paid. It is not believed that additional fees are due. In the event, however, that that the previously enclosed check was (or is) found to be insufficient, or if any additional fees are due with respect to the filing of this paper, please charge Counsel's Deposit Account Number 50-2222.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Flanagan", written over a horizontal line.

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